

REMARKS

At the outset, Applicants wish to thank Examiners Holleran and Caputa for their insightful comments and for the courtesy extended to the undersigned and to Duncan Greenhalgh during a telephonic interview that took place on November 6, 2003. During the telephonic interview, the rejections under 35 U.S.C. § 112, the substance of which is incorporated into this paper.

Claims 24-25, 50-52, 54-55, 57-58, and 61-63 were pending in this application. Claims 24, 55, 57, and 58 are currently amended by the present amendment. Applicants hereby cancel claims 54 and 62-63 without prejudice to Applicants' right to pursue the subject matter of the cancelled claims in the present application and in related applications. Thus, upon entry of the present amendment, claims 24-25, 50-52, 55, 57-58 and 61 will be pending and presented for examination.

Claim 24 has been amended to recite detecting a ribonucleic acid molecule that encodes a protein comprising the amino acid sequence set forth in SEQ ID NO:10, wherein the ribonucleic acid molecule, if present in the sample, is indicative of the presence of cervical cancer in the human. Claim 55 has been amended to recite a binding moiety that binds specifically to a ribonucleic acid encoding a protein having an amino acid sequence set forth in SEQ ID NO:10. Support for the amendments to claims 24 and 55 is found in the application as originally filed at least, for example, at pages 23-25, 47 and 58-59 of the application and in original claims 8 and 24.

Claims 57 and 58 are amended for clarity.

The title of the application is amended for consistency with the pending claims.

The sequence listing is amended to strike SEQ ID NO: 47, the nucleotide sequence of IEF SSP 9502 as disclosed in Honore *et al.* (1994) and incorporated by reference into the present application, and SEQ ID NO: 48. The paragraph bridging pages 46 and 47 of the application is amended for consistency with the amended sequence listing. A computer-readable copy of the sequence listing is enclosed. The sequence

listing information recorded in computer readable form is identical to the written sequence listing.

Applicants believe that neither the amended sequence listing nor the other amendments to the application introduce any new matter.

Objection under 35 U.S.C. § 132

The Office action objected to the amendment filed July 30, 2001, under 35 U.S.C. § 132 as allegedly introducing a new nucleic acid sequence into the application.

Applicants disagree and submit that the nucleic acid sequence was incorporated by the reference to Honore *et al.* (1994) Gene 151:291-296 in the application as originally filed. Nevertheless, to promote prosecution of the application, Applicants have deleted without prejudice the text introduced by the amendment filed July 30, 2001, relating to the nucleic acid sequence. Applicants therefore submit that the objection under 35 U.S.C. § 132 is moot and request its reconsideration and withdrawal.

New matter rejection under 35 U.S.C. § 112, first paragraph

The Office action rejected claims 24-25, 50-52, 54, 55, 57, 58, and 61-63 under 35 U.S.C. § 112 as allegedly containing subject matter that was not described in the application as filed. Applicants disagree. Nevertheless, to promote prosecution of the application, Applicants have amended the claims without prejudice to remove the subject matter allegedly not described in the application as filed. Applicants therefore submit that the objection under 35 U.S.C. § 112, first paragraph, is moot and request its reconsideration and withdrawal.

Enablement rejection under 35 U.S.C. § 112, first paragraph

The Office action rejected claims 24, 25, 50-52, 55, 57, 58, 61 and 62 under 35 U.S.C. 112, first paragraph, stating that “the specification, while being enabling for methods of detection of mRNA that encodes a protein of SEQ ID NO: 10 for the purpose of diagnosing cervical cancer,” allegedly did not “reasonably provide enablement for

methods of detection of genomic DNA for the purpose of diagnosing cervical cancer” (Office action, page 4). Applicants have amended claim 24 to recite detecting a ribonucleic acid molecule that encodes a protein comprising the amino acid sequence set forth in SEQ ID NO:10, wherein the ribonucleic acid molecule, if present in the sample, is indicative of the presence of cervical cancer in the human. Claim 55 has been amended to recite contacting a sample with a binding moiety that binds specifically to a ribonucleic acid encoding a protein having an amino acid sequence set forth in SEQ ID NO:10. Applicants submit that the claims are fully enabled by the specification (see, for example, pages 23-25 providing nucleic acid based assays for cervical cancer and pages 47, 58 and 59 describing SEQ ID NO: 10). Accordingly, Applicants request reconsideration and withdrawal of this rejection.

Rejection under 35 U.S.C. § 112, second paragraph

The Office action rejected claims 57 and 58 under 35 U.S.C. § 112, second paragraph, as allegedly indefinite. Specifically, the Office action alleged that the recitation of “the nucleic acid” lacked clear antecedent basis. Applicants have amended the claims to recite that “the binding moiety is a nucleic acid.” Applicants submit that the amended claims are definite and request reconsideration and withdrawal of the rejection.

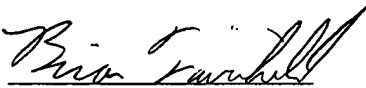
CONCLUSION

Applicants submit that the application is in condition for immediate allowance. The Examiner is requested to contact the undersigned if there are any remaining issues to be resolved.

Respectfully submitted,

Date: November 20, 2003
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